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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,443	09/05/2003	Dan Kikinis	2222.2340002	1634
26111	7590	03/30/2006		
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			EXAMINER HARRELL, ROBERT B	
			ART UNIT 2142	PAPER NUMBER

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,443

Applicant(s)

KIKINIS, DAN

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: see attached Office Action.

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1. Claims 1-13 are presented for examination.
2. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings (i.e., *there is a figure 3 but no mention in the textual portion of the specification, there is an element 28 in figure 1 with no reference in the textual portion of the specification, exc...*) along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for “the” and “said” within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required to the claimed “packet switched network”. The only reference to a “packet switched network” is to that in paragraph [0005] (page 2 (line 6) of the specification as originally filed).
4. The amendment filed 10 January 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the claimed “packet switched network”. Applicant is required to cancel the new matter in the reply to this Office Action. Also see MPEP 706.03 and MPEP 608.04 with respect to NEW MATTER.
5. The following is a quotation of the first paragraph of 35 U.S.C 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure for the reasons indicated infra.

7. The specification fails to provide any written description nor any enablement for the newly claimed "packet switched network" as now recited in the claims; and thus the specification is twice objected, one for failing to provide a written description and one for failing to provide an enablement. While the specification did originally detail two networks, a specific network and a general network, such were shown as in figure 1 with each being a connection-oriented switched telephony network via the PSTN over 17. The Internet Appliance, per figure 1, had only one connection (via 17) for the specific network and the general network but not an additional connection to a packet switched network. Element 17 is a COST not a LAN.

8. *Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph*, for the reasons set forth in the objection to the specification as failing to provide a written description.

9. *Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph*, for the reasons set forth in the objection to the specification as failing to provide an enablement.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

11. *Claims 1-13 are rejected under 35 U.S.C. 102 (e)* as being anticipated by

Giordano, III et al. (United States Patent Number: US 6,370,141 B1).

12. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

13. The rejection, and grounds for rejection, under 35 U.S.C. 102(e) as presented in examiner's prior Office Action mailed 10 August 2005, are hereby maintained and incorporated in this Office Action by reference.

14. The applicant argued in his 10 January 2006 response by stating in substance that Giordano does not disclose, teach, or suggest:

a) a control routine configured to execute on a server to use data, stored by the server during a performance of the control routine rather than received by the server from a packet switched network during the performance of the control routine, to configure a packet switched network appliance to have access to the packet switched network. Consequently, claim 1 is not anticipated by Giordano. Claims 2-4 depend upon claim 1. Accordingly, claims 2-4 are also not anticipated by Giordano. However, in light of the changed scope of the claimed invention, the server recited in examiner's prior office action now extends to the Web Site covered in figure 2 as thus would be elements (16 (i.e., LAN/Modems/and other ISP related gear), 28, 20, 22, and/or figure 2 and/or figure 3). Since the Internet Appliance was connected to the Internet Service Provider and/or the Web Site via a dial-up modem, data received by/from the server and the Internet Appliance was done so via a connection-oriented switched telephony network rather than a packet switched network. Giordano also taught a control routine configured to execute on a server (e.g., see figure 2 and figure 3) to use data, stored by the server during a performance of the control routine rather than received by the server from a packet switched network during the performance of the control routine, to configure a packet switched network appliance to have access to the packet switched network per col. 3 (line 41-et seq.), col. 5 (line 61-et seq.), and the inherited Web Server

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software and/or server program as enumerated by col. 6 (line 60-et seq.). Consequently, claim 1 was anticipated by Giordano. Claims 2-4 depend upon claim 1 and accordingly, claim 2, claim 3, and claim 4 were also anticipated by Giordano;

b) a control routine configured to execute on a server to use data, stored by the server during a performance of the control routine rather than received by the server from a packet switched network during the performance of the control routine, to configure a packet switched network appliance to have access to the packet switched network. Consequently, claim 5 is not anticipated by Giordano. Claims 6 and 7 depend upon claim 5. Accordingly, claims 6 and 7 are also not anticipated by Giordano. However, as indicated above, in light of the changed scope of the claimed invention, the server recited in examiner's prior office action now extends to the Web Site covered in figure 2 as thus would be elements (16 (i.e., LAN/Modems/and other ISP related gear), 28, 20, 22, and/or figure 2 and/or figure 3). Since the Internet Appliance was connected to the Internet Service Provider and/or the Web Site via a dial-up modem, data received by/from the server and the Internet Appliance was done so via a connection-oriented switched telephony network rather than a packet switched network. Giordano also taught a control routine (e.g., see col. 6 (line 60-et seq.)) configured to execute on a server to use data, stored by the server during a performance of the control routine rather than received by the server from a packet switched network during the performance of the control routine, to configure a packet switched network appliance to have access to the packet switched network per col. 3 (line 41-et seq.), col. 5 (line 61-et seq.), and the inherited Web Server software and/or server program as enumerated by col. 6 (line 60-et seq.). Consequently, claim 5 was anticipated by Giordano. Claim 6 and claim 7 depend upon claim 5 and accordingly, claim 6 and claim 7 were also anticipated by Giordano;

c) a control routine configured to execute on a server to use data, stored by the server during a performance of a configuration routine rather than received by the server from a packet switched network during the performance of the configuration routine, to configure a packet switched network appliance for access to the packet switched network. Consequently, claim 8 is not anticipated by Giordano. Claims 9 and 10 depend upon claim 8. Accordingly, claims 9 and 10 are also not anticipated by Giordano. However, as indicated above, in light of the changed scope of the claimed invention, the server recited in examiner's prior office action now extends to the Web Site covered in figure 2 and thus would be elements (16 (i.e., LAN/Modems/and other ISP related gear), 28, 20, 22, and/or figure 2 and/or figure 3). Since the Internet Appliance was connected to the Internet Service Provider

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and/or the Web Site via a dial-up modem, data received by/from the server and the Internet Appliance was done so via a connection-oriented switched telephony network rather than a packet switched network. Giordano also taught a control routine configured to execute on a server to use data, stored by the server during a performance of a configuration routine rather than received by the server from a packet switched network during the performance of the configuration routine, to configure a packet switched network appliance for access to the packet switched network per col. 3 (line 41-et seq.), col. 5 (line 61-et seq.), and the inherited Web Server software and/or server program as enumerated by col. 6 (line 60-et seq.). Consequently, claim 8 was anticipated by Giordano. Claims 9 and 10 depend upon claim 8 and accordingly, claim 9 and claim 10 were also anticipated by Giordano.

15. Examiner has reconsider claims 1-10, in addition to claim 11, claim 12, and claim 13, and continues to rejection these claims under 35 U.S.C. 102(e). Because, Giordano taught a system (e.g., see figure 1) for configuring a packet switched network appliance (e.g., see figure 1 (10, 12, 26, and 28)), comprising:

a) a server (e.g., see figure 1 (16, 18, 20, and 22) and/or figure 2 and/or figure 3) configured to store first data (i.e., run time variables of col. 6 (lines 60-et seq.) and any other inherited/implied Web Server software/program), to receive second data (e.g., see col. 4 (lines 25-49)) from the packet switched network appliance via a connection-oriented switched telephony network (e.g., see figure 1 (14)) rather than a packet switched network (e.g., see figure 1 (16 (Server Gear such as a LAN))), and to convey third data to the packet switched network appliance via the connection-oriented switched telephony network rather than said packet switched network (e.g., see Abstract (i.e., the new configuration data); and,

b) a control routine configured to execute on said server (e.g., see col. 5 (line 61-et seq.) and/or col. 6 (line 60-et seq.)) and to use said first data and said second data to produce said third data (e.g., see figure 3, and Abstract), wherein said first data is stored by said server during a performance of said control routine rather than received by said server from said packet switched network during said performance of said control routine (i.e., variable data during run time (pc counter, registers, stacks, exc...)) and said third data configures the packet switched network appliance to have access to said packet switched network (e.g., see Abstract). Also anticipated were claim 2, claim 3 and claim 4 per figure 1 which shows a publicly switched telephone network and a Web Server, in part on figure 3, that received information from a packet switched network (Internet) to modify the first data during operation run time of the Web Site/Server (i.e., another Web hit opens a new port causing state data to change) and for interacting with a

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compatible control server on the Internet Applicant per col. 4 (line 50-et seq.)). Furthermore, Giordano clearly taught the Internet Appliance using the modem to connect to a Server (i.e., Internet Service Provider). Thus, it was anticipated for the appliance to call once, obtain configurations, hang-up, and call again (i.e., a different provider using a different type of network based on the new configuration)). Also, per claims 5-13, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

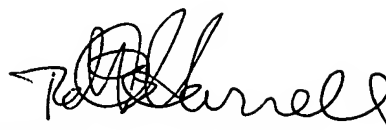
19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

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A handwritten signature in black ink, appearing to read "R. B. Harrell", with a stylized, cursive script.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142